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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,799	01/11/2002	Steven Donders	14971	5613

7590 10/30/2003
Scully Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

SCHIFFMAN, JORI

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,799

Applicant(s)

DONDERS, STEVEN

Examiner

Jori R. Schiffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20, 23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 is/are allowed.
- 6) ☒ Claim(s) 20, 23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 20 and 23 are objected to because of the following informalities: The phrase “the outer lateral surface” in claims 20 and 23 should read --an outer lateral surface--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims, the phrase “reducing the hardness” is indefinite because there is no basis for comparison for the hardness of the joint. The claims were examined as best understood. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

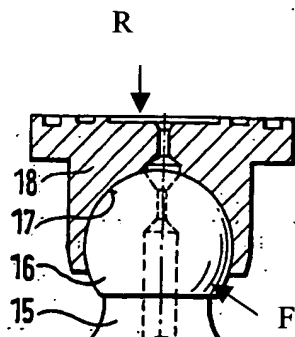
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagenseil (US 5007332).

Regarding claims 20 and 23, Wagenseil discloses (Fig. 1) a ball-and-socket joint (16, 17) forming a connection between a piston 1 and a slipper 18 of a piston machine, the joint comprising a hemispherical joint recess 17 having a free recess edge, labeled as F on the Figure below, provided at one end of the piston, and a spherical joint ball 16 on the slipper being pivotably mounted in the joint recess 17. Wagenseil further discloses an outer lateral surface converging conically toward the free recess edge F, and the piston being made of hardened steel which is hardened through nitriding (col.4, l. 1-5).

Wagenseil does not specifically disclose that the free recess edge is formed by hot-beading. However, applicant is reminded that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore this limitation has not been given patentable weight.



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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagenseil (US 5007332).

Referring to claims 26 and 27, Wagenseil discloses the claimed joint except for the slipper being formed of steel. Applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It would have been obvious at the time the invention was made to a person of ordinary skill in the art to construct the slipper of Wagenseil of steel since it is a well-known material used in ball-and-socket joints including pistons and slippers.

8. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagenseil (US 5007332) as applied to claims 23, 26, and 27 above, and further in view of Wiethoff (US 3828654).

Regarding claim 28, Wagenseil discloses the claimed joint including a base surface on the slipper with a recess, labeled as R on the Figure above, but fails to disclose the slipper including a base surface with a plate-shaped insert being mounted in the recess. Wiethoff teaches a plate shaped insert 132 mounted in the recess of the base member of the slipper. It would have been obvious at the time the invention was made to

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a person of ordinary skill in the art to include a plate shaped insert mounted in the recess of the base member of the slipper so the slipper can slide more easily.

As to claim 29, Wiethoff fails to disclose the material from which the plate shaped insert is made. Applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It would have been obvious at the time the invention was made to a person of ordinary skill in the art to construct the insert of either bronze or brass since it is a well-known material in the art.

Allowable Subject Matter

9. Claims 16-19 are allowed.

10. The following is an examiner's statement of reasons for allowance: The prior art of record fails to disclose or suggest a method of forming a ball and socket joint between a slipper and a piston including the steps of heating a free recess edge to a temperature reducing the hardness of the material and hot-beading the free recess edge into a circumferentially converging configuration.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Response to Arguments

11. Applicant argues that Wagenseil fails to disclose or suggest the method of hot-beading of the joint recess. The examiner agrees. However, as discussed above, once the examiner has found a product appearing to be substantially identical in structure to the claimed product, the burden shifts to the applicant to show an unobvious difference. See MPEP 2113. Applicant has not provided "evidence establishing an unobvious difference between the claimed product and the prior art product." In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983), and thus has not overcome the rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jori R. Schiffman whose telephone number is 703-305-4805.


The examiner can normally be reached on M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1113.

Jori R. Schiffman
Examiner
Art Unit 3679

JS


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3679